



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/790,941	03/01/2004	Joseph Miller	S63.2-10812-US01	2180

490 7590 03/29/2006

VIDAS, ARRETT & STEINKRAUS, P.A.
6109 BLUE CIRCLE DRIVE
SUITE 2000
MINNETONKA, MN 55343-9185

EXAMINER

COZART, JERMIE E

ART UNIT PAPER NUMBER

3726

DATE MAILED: 03/29/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/790,941	Applicant(s) MILLER ET AL.	
	Examiner Jermie Cozart	Art Unit 3726	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 February 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) 13-19 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 March 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>6/18/04 & 9/19/05</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Applicant's election of claims 1-12 in the reply filed on 2/16/06 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

Drawings

2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the first, second, and third plates having a plurality of nests being longitudinally aligned and unaligned must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an

Art Unit: 3726

application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

3. The disclosure is objected to because of the following informalities: On page 6, line 31, "9" is objected to because it is in the incorrect reference character used, therefore it is suggested to change "9" to - 2- -, also on line 31, "11" is objected to because it is the incorrect reference character used, therefore it is suggested to change "11" to - 3- -; On page 7, line 22, "member15" is objected to because it is grammatically incorrect, therefore it is suggested to change "member15" to - member 15- -, line 29, "5" is objected to because it is the incorrect reference character used, therefore it is suggested to change "5" to - 15- -. Appropriate correction is required.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1, 2, 4, 5, 8, 10, and 11 are rejected under 35 U.S.C. 102(b) as being anticipated by Ching et al. (US 6,481,262 B2).

Ching discloses positioning assembly of a crimper apparatus (10) comprising a first plate (70) and a second plate (80), the first plate having a nest (72) to

Art Unit: 3726

accommodate at least a portion of a first cylindrical member (61) and/or at least a portion of a second cylindrical member (60), the second plate (80) having a nest (82) to accommodate at least a portion of the first cylindrical member and/or at least a portion of the second cylindrical member, the first plate (70) constructed and arranged to be separated from the second plate in a first position via first biasing member (90), and in a second position the first plate immediately adjacent to the second plate via the fingers of the user/operator, when in the second position the first plate and the second plate situated such that a first cylindrical member and the second cylindrical member would be in proper placement for joining. The first plate (70) has a nest (72) longitudinally aligned with a nest (82) on the second plate (80). A first biasing member (90) maintains the first position when activated, and a second biasing member (i.e. user/operator hands) maintains the second position when the first biasing member is not activated. The at least one plate and the second plate have a plurality of nests (72, 82), at least two nests (72) on the at least one plate (70) being longitudinally unaligned from one another and being longitudinally aligned with nests (82) on the second plate (80). The first cylindrical member is a stent retaining member (61), and the second cylindrical member is a catheter tube (60). See column 5, line 13 – column 6, line 9, and figures 3-5 for further clarification.

Note that the recitation for automatically positioning a first cylindrical member for crimping to a second cylindrical member has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use

Art Unit: 3726

of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

6. Claims 1, 2, 4, 5, and 8 are rejected under 35 U.S.C. 102(b) as being anticipated by Mott (2,314,236).

Mott discloses a positioning assembly of a crimper apparatus (19) comprising a first plate (23) and a second plate (18), the first plate (23) having a nest (see fig. 4) to accommodate at least a portion of a first cylindrical member (14) and/or at least a portion of a second cylindrical member (10), the second plate (18) having a nest (20, see fig. 2, 4) to accommodate at least a portion of a first cylindrical member and/or at least a portion of a second cylindrical member, the first plate (23) constructed and arranged to be separated from the second plate in a first position via springs (33), and in a second position the first plate immediately adjacent to the second plate via press arbor (26), when in the second position the first plate and the second plate situated such that a first cylindrical member and the second cylindrical member would be in proper placement for joining. The first plate (23) has a nest (see fig. 4) longitudinally aligned with a nest (see fig. 4) on the second plate (18). Mott discloses a first biasing member (33) that maintains the first position when activated, and a second biasing member (26) maintains the second position when the first biasing member is not activated. Both the at least one plate (23) and the second plate (18) have a plurality of nests (see fig. 5), at least two nests (the first nest is on the left side of the figure and the

Art Unit: 3726

second nest on the right side of the figure) on the at least one plate (23) being longitudinally unaligned from one another and being longitudinally aligned with nests (the first nest being on the left side of the figure and the second nest being on the right side of the figure) on the second plate (18). *See page 1, column 1, line 55 – column 2, line 54, and figures 2-4 for further clarification.*

Note that the recitation *for automatically positioning a first cylindrical member for crimping to a second cylindrical member* has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. *See In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

7. Claims 1-3 are rejected under 35 U.S.C. 102(b) as being anticipated by Macy (2,639,754).

Macy discloses a positioning assembly of a crimper apparatus (2) comprising a first plate (26) and a second plate (26), the first plate having a nest (66) to accommodate at least a portion of a first cylindrical member (57) and/or at least a portion of a second cylindrical member (59), the second plate (26) having a nest (66) to accommodate at least a portion of the first cylindrical member and/or at least a portion of the second cylindrical member, the first plate (26) constructed and arranged to be separated from the second plate in a first position wherein the plates the have not been

Art Unit: 3726

connected to or assembled with one another via pins (20), and in a second position the first plate is immediately nearby the second plate when connected to the first plate (26) via pins (20), when in the second position the first plate and the second plate situated such that a first cylindrical member and the second cylindrical member would be in proper placement for joining. The first plate has a nest (66) longitudinally aligned with a nest (66) on the second plate (26). The first plate (26) has a nest (66) longitudinally aligned with a nest (66) on the second plate (26) and with a nest (66) on a third plate (26), the third plate immediately nearby the second plate. The explanation cited above is based on the plates (26) to crimper apparatus (2) as shown in figures 1 and 3. A series of plates (26) are immediately nearby one another, and each are provided with nests (66) that are aligned with each other. *See column 3, line 21 – column 5, line 43, and figures 1, 3, and 5 for further clarification.*

Note that the recitation for automatically positioning a first cylindrical member for crimping to a second cylindrical member has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. *See In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 6 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mott (2,314,236).

Mott discloses all of the claimed subject matter except for the first biasing member being at least one solenoid and the second biasing member comprising a spring loaded force.

At the time the invention was made, it would have been an obvious matter of design choice to a person of ordinary skill in the art to form the first biasing member as a solenoid and the second biasing member comprising a spring loaded force because Applicant has not disclosed that providing the first biasing member as a solenoid or providing the second biasing member comprising a spring loaded force provides an advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected Applicant's invention to perform equally well with the first biasing member provided as spring loaded and the second biasing member provided as a press arbor because the biasing members accurately positions the assembly for crimping.

Therefore, it would have been an obvious matter of design choice to modify Mott to obtain the invention as specified in claims 6 and 7.

10. Claims 8 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Macy (2,639,754).

Macy discloses all of the claimed subject matter except for both the at least one plate and the second plate have a plurality of nests, at least two nests on the at least one plate being longitudinally unaligned from one another and being longitudinally aligned with nests on the second plate, or the third plate having at least two nests longitudinally unaligned with one another are longitudinally aligned with nests on the first plate and the second plate.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide both the at least one plate and the second plate with a plurality of nests, at least two nests on the at least one plate being longitudinally unaligned from one another and being longitudinally aligned with nests on the second plate, and to provide the third plate having at least two nests longitudinally unaligned with one another are longitudinally aligned with nests on the first plate and the second plate, since it has been held that mere duplication of essential work parts (i.e. nests) of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*

11. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ching et al. (US 6,481,262 B2).

Ching discloses the first cylindrical member being a catheter tube.

Ching does not expressly disclose the second cylindrical member being the inner tube of a catheter.

At the time the invention was made, it would have been an obvious matter of design choice to a person of ordinary skill in the art to form the second cylindrical member as the inner tube of a catheter because Applicant has not disclosed that the second cylindrical member being the inner tube of a catheter provides an advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected Applicant's invention to perform equally well with the second cylindrical being a catheter tube because the first cylindrical member is fixedly secured on the catheter tube.

Therefore, it would have been an obvious matter of design choice to modify Ching to obtain the invention as specified in claim 12.

Conclusion


12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The references cited on the attached PTO-892 are cited to show positioning assemblies of crimpers.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jermie Cozart whose telephone number is 571-272-4528. The examiner can normally be reached on Monday-Thursday, 7:30 am - 6:00 pm.

Art Unit: 3726

14. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, George Nguyen can be reached on 571-272-4491. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

15. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Jermie Cozart
Examiner
Art Unit 3726